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| EXAMINER            |             |                      |                     |                  |
| NGUYEN, TUAN VAN    |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,299

**Applicant(s)**

CHUNG, TAE JUN

**Examiner**

TUAN V. NGUYEN

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-15 is/are rejected.  
7) ☒ Claim(s) 16 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 14 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 6/19/06 11/30/09  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-16 are pending and they are presented for examination.

#### ***Specification***

2. The specification is objected to because of the following informalities: (1) paragraph [5] recites the limitation of "thedisadvantage". (2) paragraphs [8] and [26] recite the limitation of "(60)mm" and "(150)mm". Note that 25.4 mm is equal to 1 inch, thus, 60 mm would equal to 2.4 inches and 150 mm would equal to 5.9 inches. It is understood that applicant intended to recite "(60)  $\mu$ " and "(150)  $\mu$ " (see U.S. 7,276,072). (3) paragraph [9], line 2, recites the limitation of "isautomatically". (4) paragraph [31] recites the limitation of "tip60having", "shapesuch", "tube64is", "tip60but", "tip60with". Appropriate correction is required.

#### ***Claim Objections***

3. Claim 3 is objected to because of the following informalities: claim 3 recites the limitation of "(60)mm" and "(150)mm". It is understood that applicant intended to recite "(60)  $\mu$ " and "(150)  $\mu$ " (see U.S. 7,276,072). Appropriate correction is required. Examiner interprets the limitation above as "(60)  $\mu$ " and "(150)  $\mu$ " and will be considered as such for examination purpose.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ignon (U.S. 6,629,983) in view of Fields et al. (U.S. 6,019,749).**

7. Referring to claims 1 and 8, Ignon discloses (see Figs. 1, 2, 6, and 9 and col. 2, line 49 to col. 3, line 50) a skin resurfacing device comprising: a skin treater 32 comprising a hollow tube or base 34 wherein the hollow tube having a first end or distal end 43, a second end or proximal end 41; vacuum source (see Abstract) connected to the skin treater at the second end or proximal end 41; abrasive tip including cap with opening and abrasive pad 58 (see Fig. 2) or abrasive roller (see Abstract) and a filter 18 is attached to the proximal end 41 of the skin treater.

Ignon discloses the invention substantially as claimed except for disclosing the location of the filter is inside the skin treater or housing 32 instead of connected to the proximal end of the housing as suggested by Ignon. However, Fields discloses (Fig. 5 and col. 3, lines 50-58) an apparatus for cleaning the skin, more particularly for removes undesirable material from skin such as dirt and bacterial (see col. 1, lines 5-10) comprising, a skin treater and among other things, wherein the skin treater having a filter 54 and the filter is also exposed for ready for removal and replacement along the nozzle. It would have been obvious to one of ordinary skill in the art to incorporate the teaching of Fields into the device of Ignon because it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

8. **Claims 1-5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldron (U.S. 6,500,183) in view of Fields et al. (U.S. 6,019,749).**
9. Referring to claims 1-5 and 13, Waldron discloses (see Figs. 1, 2, 3, 8 and 9) a skin resurfacing device comprising: a skin treater 22 comprising a hollow tube wherein the hollow tube having a first end or distal end, a second end or proximal end with tube 32 connected the skin treater 22 to vacuum source; vacuum source 24 (see Fig. 3) connected to the skin treater 22 at the second end; abrasive tip 46, 48 with opening and abrasive materials such as aluminum oxide of about 127 microns to 151 microns (see Fig. 8); and a filter 18 is attached to the second end 41 of the skin treater 22 (col. 3, line 55 to col. 5, line 28). Waldron also discloses (see Fig. 20) an alternative embodiment having a clear housing 137 for visibility

and for easy for cleaning and sterilizing (see col. 7, lines 20-25). Waldron discloses the invention substantially as claimed except for disclosing the location of the filter is inside the skin treater. However, Fields discloses (Fig. 5 and col. 3, lines 50-58) an apparatus for cleaning the skin, more particularly for removes undesirable material from skin such as dirt and bacterial (see col. 1, lines 5-10) comprising, a skin treater, among other things, wherein the skin treater having a filter 54. Therefore, it would have been obvious matter of design choice to one of ordinary skill in the art at the time the invention was made by the applicant to have the filter be installed inside the skin treater 22 of Waldron device because it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

10. Referring to **claim 3**, Waldron discloses the abrasive materials such as aluminum oxide having the size of about 127 microns to 151 microns. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use abrasive materials such as aluminum oxide having the size of about 60 microns to 150 microns , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.
11. Referring to **claim 4**, Waldron is silent with respect the abrasive tip is made by pressure molding and heat treating abrasive particles. In view of the specification, the limitation above is interpreted as the abrasive tip is formed by a process that utilizing the step of heat treating the particles and pressure molding the particles to

form the abrasive tip. Here it is noted that a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S. P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3.

12. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldron (U.S. 6,500,183) in view of Fields et al. (U.S. 6,019,749) as applied to claim 2 above and further in view of Li (U.S. 6,667,492).**
13. Referring to claim 6, the modified device of Waldron discloses the invention substantially as claimed except for disclosing the abrasive tip is coated with liquid ceramic material. However, Li discloses that liquid coated abrasive material for polishing in many industries such as medical (see col. 2, lines 52-55) will gain the advantage of maintaining the sharpness of the abrasive particles and low cost (see col. 3, lines 35-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to coat the abrasive cap of Waldron device by the method described by Li to gain the advantage of maintaining the sharpness of the abrasive particles and low cost as suggested by Li (see col. 3, lines 35-52).

14. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldron (U.S. 6,500,183) in view of Fields et al. (U.S. 6,019,749) further in view of Li (U.S. 6,667,492) and further in view of Eilers et al. (U.S. Pub. No. 2001/0023351).**
15. Referring to claim 7, the modified device of Waldron discloses the invention substantially as claimed except for different color for a different size of abrasive particles. However, Eilers discloses abrasive particles may be coated with a coloring agent, different color coatings may be used to distinguish between particles having different size (see paragraph [0048]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to have different color for a different size of abrasive particles in order to gain the advantage of providing the user the ability to distinguish between particles having different size as suggested by Eilers.
16. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldron (U.S. 6,500,183) in view of Fields et al. (U.S. 6,019,749) and further in view of Arai et al. (U.S. 5,755,672).**
17. Referring to claim 9, the modified device of Waldron discloses the invention substantially as claimed except for the system further comprises a skin sensor that measures the oiliness of the skin. However, Arai discloses a sensor for measuring the oiliness of the skin for the purpose of providing the reference data of the skin in order to provide the most suitable cosmetic corresponding to the characteristics of the skin of the customer (see col. 1, lines 15-22). Therefore, it would have been



obvious to one of ordinary skill in the art at the time the invention was made by the applicant to incorporate the skin sensor with the system of Waldron in order to gain the advantages as suggested by Arai.

18. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldron (U.S. 6,500,183) in view of Fields et al. (U.S. 6,019,749) and further in view of Greenberg (U.S. Pub. No. 2003/0093089).**
19. Referring to claim 12, the modified device of Waldron discloses the invention substantially as claimed except for the system further comprises a timer that controls operation time of the system. However, Greenberg discloses the timer for controlling the operation time of the system it is old and well known in the art (see paragraph [0063]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to incorporate the skin sensor with the system of Waldron in order to gain the advantage of allow the apparatus to turns off after a pre-determined amount of time as suggested by Greenberg.
20. **Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldron (U.S. 6,500,183) in view of Fields et al. (U.S. 6,019,749) and further in view of Rosso (U.S. 5,207,234).**
21. Referring to claims 14 and 15, the modified device of Waldron discloses the invention substantially as claimed except for disclosing a container that comprises an open end, a lid that plugs the open end, an inlet pipe passing through the lid, an outlet pipe passing through the lid, a filter is fixed to the outlet pipe, wherein the

container is detachable from the lid. Rosso discloses (see Fig. 1) a derma-abrasion system comprises a container 10 that comprises an open end, a lid that plugs the open end, an inlet pipe 9 passing through the lid, an outlet pipe passing through the lid, a filter 12 is fixed to the outlet pipe 11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to incorporate the container, the lid with a second filter that attached to the outlet pipe passing through the lid as disclosed by Rosso into the modified device of Waldron to provide a second fail safe features if the first filter inside the hand piece is not adequately filtering infectious tissue. Here it is noted Rosso is silent with respect the lid is detachable from the container, however, it is old and well known in the art that the lid can be made integral with the container for preventing user reuses the container or the lid can be removable with the container for allowing the user to empty the container and reuse the container.

***Allowable Subject Matter***

22. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/TUAN V NGUYEN/

Examiner, Art Unit 3731